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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,716	11/19/2003	Subhash Harmalker	IR6029-01	6320

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EXAMINER
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DELCOTTO, GREGORY R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/716,716

Applicant(s)

HARMALKER, SUBHASH

Examiner

Gregory R. Del Cotto

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 8/30/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 15-30 and 32-34 are pending. Claims 1-14 and 31 have been canceled. Applicant's amendments and arguments filed 8/30/06 have been entered. Note that, the prior art rejections as set forth below are the same or in some cases, substantially the same, as the prior art rejections affirmed by the Board of Appeals in a decision rendered on 7/26/02 in case 09/086427.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/30/06 has been entered.

#### **Objections/Rejections Withdrawn**

The following objections/rejections set forth in the Office action mailed 5/3/06 have been withdrawn:

The rejection of claim 31 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, has been withdrawn.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1751

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zocchi (US 5,681,801) in view of Baravetto et al (US 5,980,877) or Inman (US 5,948,739).

Zocchi teaches a combination cleansing, conditioning composition comprising a stable, clear, aqueous cleaning phase having stably dispersed and suspended therein particles bearing the conditioning agent, the aqueous cleaning phase comprising a high foaming anionic surfactant, an amphoteric surfactant in quantities of at least 0.2 weight percent of the composition wherein the clarity of the aqueous phase is maintained, and an effective amount of a viscoelasticity enhancing system suspending material comprised of a xanthan gum having an initial transmittance in a 1 wt% distilled water solution of at least 85% as measured by a UV spectrophotometer at 600 nanometers. See Abstract. Examples of suitable anionic surfactants include alkyl sulfates, alkyl sulfonates, alkyl ether sulfates, etc., in which the alkyl chain contains from 8 to 20 carbon atoms. The anionic surfactants can be alkoxylated, preferably ethoxylated and

Art Unit: 1751

are generally present in quantities of at least 2% by weight. See column 2, lines 14-20. Suitable amphoteric surfactants include cocoamido propyl or ethyl betaines. See column 2, lines 40-56. Additionally, a nonionic surfactant is optionally included in the composition in amounts from 0.75% to about 7% by weight. See column 3, lines 15-20.

The composition provides a unique method for delivering conditioning agents to the skin and hair. The particles suspended in the aqueous cleansing phase bear on and/or inside their surface conditioning agents such as emollients, anti-oxidants, vitamins, mineral oils, vegetable oils, and any other oil like material applied to the skin or hair for conditioning effect. Preferably, the particle size of the particulate suspended phase bearing the conditioning agent is from about 200 to about 2500 microns. See column 3, line 45 to column 4, line 15. The particle size of the xanthan gum material used in the compositions are such that 100% goes through 60 mesh (250 micron) screen. See column 4, lines 40-55. The xanthan gum should be present from about 0.3% to about 1% by weight of the composition. See column 5, lines 1-15.

However, Zocchi does not teach a personal cleansing composition containing hydroxypropyl guar gum or hydroxyethyl guar gum nor specifically teach a personal aqueous cleansing/conditioning composition containing an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and hydroxypropyl guar gum or hydroxyethyl guar gum and particles bearing a conditioning agent suspended in an aqueous phase in the specific proportions as recited by the instant claims.

Baravetto et al teach aqueous conditioning shampoo compositions containing a surfactant component in a shampoo with a particulate insoluble, dispersed, non-volatile conditioning agent having a dual particle size range, suspending agent, and a deposition polymer. See Abstract. The shampoo compositions comprise a deterative surfactant suitable for use on hair or skin. Suitable surfactants include anionic surfactants, nonionic surfactants, amphoteric surfactants, or mixtures thereof. The purpose of the deterative surfactant is to provide cleansing performance to the composition. See column 4, lines 60-59. The shampoo compositions further comprise a suspending agent at concentrations effective for suspending the conditioning agents. The concentrations range from about 0.1% to about 10% by weight. Suitable suspending agents include xanthan gum, carboxyvinyl polymers, etc. Other suitable suspending agents may be used in the compositions, including those that can impart a gel-like viscosity to the composition, such as hydroxypropyl guar gum, etc.

Inman teaches hair conditioning shampoo compositions containing a deterative surfactant component, a silicone hair conditioning agent, water, and preferably comprising a suspending agent for the silicone conditioning agent. See Abstract. Any suspending agent can be used including xanthan gum, carboxyvinyl polymers, etc. See column 13, line 30 to column 14, line 20. Another type of suspending agent that can be used includes hydroxypropyl guar gum, starch, etc. These suspending agents are used at a level of from about 0.1% to about 10% by weight of the composition. See column 15, lines 25-40.

It would have been obvious to one of ordinary skill in the art to use hydroxypropyl guar gum in place of a portion of xanthan gum as a thickening agent in the hair cleansing/conditioning composition taught by Zocchi having the same physical parameters as the xanthan gum taught by Zocchi, with a reasonable expectation of success, because Baravetto et al or Inman teach the equivalence of xanthan gum to hydroxypropyl guar gum as thickening agents in similar hair care compositions. Note that, an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Also, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Note that, Applicant has demonstrated no criticality with respect to a mixture of xanthan gum and hydroxypropyl guar gum as the thickening agent.

Note that, it would have been obvious to one of ordinary skill in the art to use hydroxyethyl guar gum in place of a portion of xanthan gum instead of hydroxypropyl guar gum in the compositions taught by Zocchi for the same reasons set forth above, with a reasonable expectation of success, because hydroxyethyl guar gum and hydroxypropyl guar gum (as taught by Baravetto et al or Inman) have very close structural similarities and would be expected to have similar properties. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. An obviousness rejection based on similarity



Art Unit: 1751

in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. See MPEP 2144.09.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a personal aqueous cleansing/conditioning composition containing an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and hydroxypropyl guar gum or hydroxyethyl guar gum, particles bearing a conditioning agent suspended in an aqueous phase, and the other requisite components of the composition in the specific proportions as recited by the instant claims because the broad teachings of Zocchi in combination with Baravetto et al or Inman suggest a personal aqueous cleansing/conditioning composition containing an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and hydroxypropyl guar gum or hydroxyethyl guar gum, and particles bearing a conditioning agent suspended in an aqueous phase in the specific proportions as recited by the instant claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-30 and 32-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,681,801 (Zocchi) in view of Baravetto et al (US 5,980,877) or Inman (US 5,948,739). Claims 1-14 of US 5,681,801 recite a personal cleansing/conditioning composition encompassing all the material limitations of instant claims 15-30 and 32-34 except for the inclusion of hydroxypropyl or hydroxyethyl guar gum.

Baravetto or Inman et al teach similar personal cleaning compositions which show the equivalence of xanthan gum to hydroxypropyl guar gum or hydroxyethyl guar gum as thickening agents.

It would have been obvious to one of ordinary skill in the art to use hydroxypropyl or hydroxyethyl guar gum in place of a portion of xanthan gum as a thickening agent in the hair cleansing/conditioning composition claimed by Zocchi having the same physical parameters as the xanthan gum taught by Zocchi with the expectation of success since Baravetto or Inman et al teach the equivalence of xanthan gum to hydroxyl propyl or hydroxyl ethyl guar gum as thickening agents in similar hair care compositions.

Note that, instant claims 1-14 of US 5,681,801 (Zocchi) in view of Pyles or Bolich, Jr. et al encompass the material limitations of instant claims 15-30 and 32-34.

### ***Response to Arguments***

With respect to the rejection of the instant claims using Zocchi in view of Baravetto or Inman, Applicant states that there is no motivation to combine Zocchi with

Art Unit: 1751

Baravetto or Inman because Baravetto or Inman do not disclose the selection of dual mechanisms provided for by xanthan gum and guar gum. In response, note that, as stated previously, both Baravetto or Inman are secondary references relied upon for their teaching of the equivalence of hydroxypropyl guar gum to xanthan gum in a similar cleaning composition. The Examiner maintains, as stated previously, that there is clear motivation to use hydroxy propyl guar gum in place of a portion of xanthan gum as a thickening agent in the hair cleansing/conditioning composition taught by Zocchi having the same physical parameters as the xanthan gum taught by Zocchi, with a reasonable expectation of success, because Baravetto et al or Inman teach the equivalence of xanthan gum to hydroxypropyl guar gum as thickening agents in similar hair care compositions. Note that, the fact that xanthan gum and guar gum function in different ways to thicken is not relevant nor does it negate the motivation to use them together; the fact of the matter is that they are both well-known and conventionally used thickeners in cleaning compositions, regardless of how they thicken. Note that, an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Also, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, a rejection which used the same rationale and motivation to combine xanthan gum and guar gum as a thickening agent was affirmed by the Board of Patent Appeals in a decision rendered on 7/26/02 in

Art Unit: 1751

case 09/086427. Thus, the Examiner maintains that Zocchi in combination with Baravetto et al or Inman is sufficient to suggest the claimed composition under 35 USC 103. Note that, the double patenting rejection of the instant claims using Zocchi in view of Baravetto et al or Inman has been maintained for the same reasons as set forth above.

With respect to instant claims 23 and 32-34, Applicant states that there is no suggestion in the references of having the amount of xanthan gum greater than the amount of guar gum or the viscosity or flow characteristics in new claims 32-34. In response, note that, Zocchi teaches that xanthan gum should be present in amounts from 0.3 to 1% by weight of the composition and as stated above, it would be obvious to replace a portion of the xanthan gum with guar gum because of the equivalency of the these compounds as thickening agents. Thus, the Examiner asserts that one skilled in the art would be motivated to use a mixture of xanthan gum and guar gum in which xanthan gum is present in a higher amount than guar gum as recited by instant claim 23. With respect to instant claims 32-34, the Examiner asserts that the teachings of Zocchi in combination with Baravetto et al or Inman would suggest compositions having the same viscosity and flow characteristics as recited by instant claims 32-34 because Zocchi in combination with Baravetto et al or Inman suggest compositions containing the same components in the same amounts as recited by the instant claims.

### ***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory R. Del Cotto

Application/Control Number: 10/716,716  
Art Unit: 1751

Page 13

Primary Examiner  
Art Unit 1751

GRD  
August 31, 2006